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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,820	12/11/2001	Bertrand du Castel	M-12236 US	1681
41754	7590	06/15/2006	EXAMINER	
ANDERSON & JANSSON L.L.P. 9501 N. CAPITAL OF TX HWY #202 AUSTIN, TX 78759			BHATIA, AJAY M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,820

Applicant(s)

DU CASTEL ET AL.

Examiner

Ajay M. Bhatia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/20/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Arguments***

Applicant's arguments filed 4/20/06 have been fully considered but they are not persuasive.

Applicant merely argues applicant's amendment to claims differentiates over the prior art. Presently applicant amendments are new matter, which is not supported by the specification. Support provided on page 9 of the specification disclose "characteristics of the content" shall mean characteristics inherent to the content and relative to caching, independent of metadata such as file names, date stamps and the like." Which the first part of the definition is negated by the second part of the definition "characteristics of content" is negated by "independent of metadata." As the Microsoft Computer Dictionary Fourth Edition defines "metadata" as "data about data" which would be inclusive of "characteristics of content" use in light of the specification for caching. Presently the definition and claim as written does not allow any person of skill in the field of invention able to create a structure that is in compliance with applicant provided definition on page 9 of the specification. Therefore since applicant's arguments are directed toward these limitation in light of the interpretation they are not persuasive.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended and included the limitation independent of descriptors of the content, date stamps and /or file names associated with the content. The specification does not provide support for descriptors of the date stamps, and/or file names.

Additionally applicant defines "characteristic of content" in the claim as indicative of content permanency, and independent of descriptors of the content, date stamps, and/or file names associated with the content. Presently the specification discloses "characteristics of the content" shall mean characteristics inherent to the content and relative to caching, independent of metadata such as file names, date stamps and the like."

Additionally applicant has failed to point out where in the specification that applicant has provided support of all the possible combination of characteristics of content being independent of the content, date stamps, and/or file names associated with the content.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: in disclosure of applicant definition of characteristics of the content for caching, independent of metadata applicant has failed to disclose the structural connection that make independent of metadata separate from inherent to the content.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Schloss et al. (U.S. Patent 6,249,844 referred to as Schloss).

For claim 1, Schloss teaches, a method for reducing transmissions of content between a gateway and one or more clients, the method comprising:

Identifying content for transmission by determining a plurality of characteristics of the content, consisting of characteristics inherent to the content, relative to caching including at least one static characteristic of content; and  
sharing the determination of the plurality of characteristics of content indicative of content permanency, and independent of descriptors of the content , data stamps, and/or file names associated with the content , and ; with the gateway and the one or more clients, the sharing to enable the gateway to filter content for transmission to the one or more clients based on the plurality of characteristics thereby reducing an amount of content for transmission between the gateway and the one or more clients. (Schloss, Col. 5 line 57 to Col. 6 line 30)

For claim 2, Schloss teaches, the method of claim 1 further comprising:  
updating the gateway with a later determination of the plurality of characteristics of content, the updating including adding data to a container associated with the gateway.  
(Schloss, Col. 5 line 57 to Col. 6 line 30)

For claim 3, Schloss teaches, the method of claim 2 wherein the container is a database. (Schloss, Col. 5 lines 37-52)

For claim 5, Schloss teaches, the method of claim 1 wherein the determining is done by one or more of a user of the client and an issuer of the client. (Schloss, Col. 5 line 57 to Col. 6 line 30)

For claim 6, Schloss teaches, the method of claim 5 wherein the issuer identifies static content via a communication with the gateway. (Schloss, Col. 7 lines 48-67)

For claim 7, Schloss teaches, the method of claim 5 wherein the user identifies static content via a setup program. (Schloss, Col. 7 lines 48-67)

For claim 10, Schloss teaches, the method of claim 1 further comprising:  
recording one or more unique identifiers associated with the determination of the plurality of characteristics of content, the unique identifier identifying content chosen for caching according to at least one characteristic of the plurality of characteristics of content;  
comparing the unique identifier to a list of unique identifiers recorded by the gateway;  
and  
if the list holds the unique identifier, transmitting to the client the content as filtered by removing content identified by the unique identifiers. (Schloss, Col. 7 lines 48-67)

Claims 12-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoyle (U.S. Patent 6,141,010).

For claim 12, Hoyle teaches, a computer readable storage medium comprising computer instructions for:

reading a container, the container identifying content not to be distributed according to at least one characteristic of the content, consisting of characteristic inherent to the content, relative to caching, and independent of descriptors of the content, date stamps and /or file names associated with the content and including a determination of usefulness of the content to a user; (see Hoyle, Col. 8 lines 53-63, usefulness is the demographic information which is used to adapt the information to the user)

comparing the container with received content for distribution to a client; and

if the container identifies the received content as including one or more subsets of content identified as not to be distributed, filtering the subsets from the content. (see Hoyle, Col. 8 lines 36-52, filtering subsets is done during display and retrieval of content since content is retrieved based upon demographic information, and display according to what is required for the location)

For claim 13, Hoyle teaches, the computer readable storage medium of claim 12 wherein the container is a one of a database and a file list. (see Hoyle, Col. 7 lines 48-57, Col. 9 lines 1-11, the ADM is a database and a file list)



For claim 14, Hoyle teaches, a method of managing content in a gateway, the method comprising:

reading a container, the container identifying content not to be distributed according to at least one characteristic of the content consisting of characteristic inherent to the content, relative to caching, and independent of descriptors of the content, date stamps and /or file names associated with the content; (see Hoyle, Col. 8 lines 53-63, Col. 8 lines 36-52 based on demographics info)

comparing the container with received content for distribution to a client; and

if the container identifies the received content as including one or more subsets of content identified as not to be distributed, filtering the subsets from the content. (see Hoyle, Col. 8 lines 36-52)

For claim 15, Hoyle teaches, the method of claim 14, further comprising:

if the subsets from the content are filtered, inserting one or more unique identifiers into the content. (see Hoyle, Col. 5 lines 47-65, Col. 9 lines 1-11, associate with category identify and in addition to the identifier in the content)

For claim 16, Hoyle teaches, the method of claim 15 wherein the gateway transmits the filtered content to the client via a communication channel in response to a request for content for loading a linked set of files defining a web page, the linked set of files including content having a static characteristic and dynamic content, wherein the

content identified as having at least one static characteristic is associated with the one or more unique identifiers. (see Hoyle, Col. 5 lines 47-65)

For claim 17, Hoyle teaches, the method of claim 14 wherein the gateway has a contractual relationship with the client. (see Hoyle, Col. 6 line 62 to Col. 7 line 12, the contractual relationship is that the program is provided with the advertising system, and user is able to make use of the program with the presence of the advertising)

For claim 18, Hoyle teaches, the method of claim 14 wherein the characteristics of the content include a static characteristic of the content. (see Hoyle, Col. 5 lines 47-65)

For claim 19, Hoyle teaches, the method of claim 14 wherein the characteristics of the content include a plurality of characteristics according to one or more of a determination as to a level of inactivity and a plurality of predetermined parameters for adjusting the content. (see Hoyle, Col. 5 lines 47-65, Col. 7 lines 48-57)

For claim 20, Hoyle teaches, the method of claim 14 wherein the content is stored on a machine readable medium coupled to a first digital machine and wherein the first digital machine transmits content via a communication channel to a second digital machine, wherein:

the characteristic of the content associated with the container is a static characteristic;

the comparing includes determining whether the container identifies content for distribution to second digital machine that is held in a cache of the second digital machine; and (see Hoyle, Col. 7 lines 1-11, Col. 7 lines 26-46, it is inherent form the context of the citation that the system support a multiple computers)

if the second digital machine cache holds content identified in the container, the content is stored in a readable/writeable memory locally coupled to the second digital machine. (see Hoyle, Col. 10 lines 35-51)

For claim 21, Hoyle teaches, the method of claim 20 wherein the second digital machine is one of a personal computer, a portable computing device, and a mobile telephone. (see Hoyle, Col. 7 lines 26-46)

For claim 22, Hoyle teaches, the method of claim 20 wherein the second digital machine is configured to execute one or more of telephony, appointment planning, and personal computing. (see Hoyle, Col. 7 lines 26-46, Col. 7 lines 1-11, a feature inherent to windows operating system)

For claim 23, Hoyle teaches, a system comprising:

a processor;

a first memory coupled to the processor; (see Hoyle, Col. 7 lines 1-11, Col. 7 lines 26-46)

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a first instruction set operable with the processor to compare a container in the memory to determine whether content for transmission matches at least a subset stored in a second memory within a receiving device, wherein the subset is identified as static content previously cached in the receiving device and content previously identified as not to be transmitted to the receiving device; and (see Hoyle, Col. 8 lines 53-63, Col. 8 lines 36-52)

a second instruction set operable with the processor to filter the content for transmission by removing the subsets. (see Hoyle, Col. 8 lines 53-63, Col. 8 lines 36-52)

For claim 24, Hoyle teaches, the system of claim 23 wherein the system is a gateway configured to transmit filtered content to the receiving device. (see Hoyle, Col. 5 lines 47-65)

For claim 25, Hoyle teaches, the system of claim 23 wherein the second instruction set further inserts a plurality of unique identifiers into the filtered content, the plurality of unique identifiers marking the filtered content for the receiving device to insert cached content. (see Hoyle, Col. 5 lines 47-65)

For claim 26, Hoyle teaches, the system of claim 23 further comprising a transmitter responsive to the determination of the first and second instruction sets. (see Hoyle, Col. 5 lines 47-65, Col. 8 lines 36-52)

For claim 27, Hoyle teaches, the system of claim 23 wherein the receiving device is one of a smart card and a memory module coupled to one of a mobile telephone, a personal digital assistant, a personal computer, and a mobile computing device. (see Hoyle, Col. 7 lines 26-46, Col. 7 lines 1-11)

For claim 28, Hoyle teaches, the system of claim 23 wherein the memory includes: storage for the content with the static characteristic; and a database for holding a list of unique identifiers. (see Hoyle, Col. 7 lines 48-57)

For claim 29, Hoyle teaches, the system of claim 25 wherein: the receiving device receives the plurality of unique identifiers via a communication channel in response to a request for content for loading a linked set of files defining a web page, the linked set of files including content having a static characteristic and dynamic content, wherein the content identified as having at least one static characteristic is associated with the plurality of unique identifiers. (see Hoyle, Col. 5 lines 47-65, Col. 7 lines 48-57)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schloss in view of Sloan (U.S. Patent 6,179,205).

For claim 4, Schloss teaches, the method of claim 1 wherein the determining is done one of:

after manufacture of the one or more components for the client, the client or the gateway performing the determining according to decisions one or both of by the client and the gateway.

Schloss fails to teach, prior to manufacture of one or more components for the client, the components including one or more of a smart card, a removable device for a computer system, and a wireless transmission component for the client; (Schloss, Col. 5 line 57 to Col. 6 line 30)

Sloan teaches, prior to manufacture of one or more components for the client, the components including one or more of a smart card, a removable device for a computer system, and a wireless transmission component for the client; (see Sloan, Col. 6 lines 45-62)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Schloss with the method of Challenger are improving the capabilities of non computer devices. (Schloss, Col. 1 lines 18-36) and (see Sloan, Col. 1 lines 25-40)

For claim 11, Schloss-Sloan teaches, the method of claim 1 wherein the determining one or more characteristics provides a cached set of files for a smart card. (see Sloan, Col. 6 lines 45-62) The same motivation that was utilized in the rejection of claim 4, applies equally as well to claim 11.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schloss in view of Challenger et al. (U.S. Patent 6,507,891 referred to as Challenger).

For claim 8, Schloss fails to teach, the method of claim 1 wherein the determining is done dynamically by the gateway, the gateway running software adapted to determine whether content is cached in the one or more clients.

the method of claim 1 wherein the determining is done dynamically by the gateway, the gateway running software adapted to determine whether content is cached in the one or more clients. (see Challenger, figure 5 and Col. 7 lines 47-67)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Schloss with the method of Challenger because both disclose information improvements to web browsing software. (Schloss, Col. 1 lines 37-51) and (see Challenger, Col. 1 line 58 to Col. 2 line 15)

Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schloss-Sloan in view of Hoyle (U.S. Patent 6,141,010).

For claim 9, Schloss-Sloan teaches, the method of claim 4 wherein the decisions include one or more of:

a decision that an identified content type will be cached in the client and require updating according to a predetermined frequency;

a decision regarding a number of bytes for each transmission;

a decision regarding an amount of time for a transmission;

a contractual agreement regarding reduced transmissions;

a decision made via a setup program for governing transmissions; and

a decision with respect to a static characteristic of a linked set of files for a web site, the linked set of files having a hierarchy, wherein the linked set of files is shared with the gateway with the static characteristic determining the filtering of the content. (Schloss, Col. 6 lines 30-57) The same motivation that was utilized in the rejection of claim 4, applies equally as well to claim 9.

Schloss-Sloan fail to clearly disclose, two

Hoyle teaches, two (see Hoyle. Col. 15 lines 48-53, a display hierarchy, Col. 7 lines 47-57, all banner that are cached are inherently dynamic information, in addition banners are periodically retrieved and cached in the ADM, Col. 8 lines 41-46)



It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Schloss-Sloan's method of providing static and dynamic content with the use of a smart card to store static content and Hoyle's second method of decision. Since it is well known in the art that decisions are done using boolean logic in computers, and the addition of additional decisions improves the adaptability of the program to tailor itself to the user. These concepts are fundamental to design and development of software.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached UPSTO 892 (if appropriate).

This is a request for continued examination of applicant's earlier Application No. 10/014,820. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jason Cardone  
Supervisor Patent Examiner  
Art Unit 2145

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